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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/382,907	08/25/1999	TIMOTHY M. KEISER	10269/11	5840

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EXAMINER

ROBINSON BOYCE, AKIBA K

ART UNIT PAPER NUMBER

3623

DATE MAILED: 04/30/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/382,907

Applicant(s)

KEISER ET AL.

Examiner

Akiba K Robinson-Boyce

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 10/10/02.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1,3-9 and 11-14 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 3-9, 11-14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

## **DETAILED ACTION**

### ***Status of Claims***

1. Due to the amendment filed 9/16/02 and the response filed 10/10/02, the following is a final office action. The amendment filed 9/16/02 has been entered. The previous rejection has been sustained. Claims 2 and 10 have been cancelled by amendment. Claims 15-41 are non-elected due to the restriction requirement given in the rejection mailed out 5/9/02. Claims 1, 3-9 and 11-14 remain pending in this application and have been examined on the merits.

### ***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1, 3, 8, 9, 11, 13, and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nymeyer (US Patent 3,581,072), and further in view of Fernholz (5,819,238).

As per claims 1, 9, 14, Nymeyer discloses:

Measuring an imbalance.../means for measuring an imbalance...(Col. 7, lines 64-74);

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Computing a projected price movement.../means for computing a projected price movement (Col. 7, lines 71-74);

Setting a market price.../means for setting a market price ... (Abstract, lines 1-3);

Automatically generating additional buy orders.../means for automatically generating additional buy orders... (Col. 11, line 68-Col. 12, line 3).

Nymeyer fails to disclose the following, however Fernholz discloses:

Generating the electronic currency.../means for generating the electronic currency (Col. 12, lines 16-17, here Fernholz discloses the custodial bank holds electronic cash which is distributed for trade purposes).

Crediting/debiting.../means for crediting/debiting (Col. 12, lines 50-55).

It would have been obvious to one of ordinary skill in the art to generate electronic currency and to credit or debit the traders' accounts with electronic currency for executed buy/sell orders with the motivation of initiating and finalizing the trade.

As per claims 3, 11, Nymeyer discloses:

Further comprising exchanging the Hollywood dollars in the first or second trader's account.../further comprising means for exchanging the Hollywood dollars in the first or second trader's account ... (Col. 1, lines 12-29, wherein claim limitation is merely describing a trade).

As per claims 8, 13, Nymeyer discloses:

Wherein the additional buy orders or sell orders for the instrument are automatically generated at the market price... (Col. 7, lines 44-61).

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4. Claims 4-7, 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nymeyer (US Patent 3,581,072), and further in view of Fernholz (5,819,238), and further in view of Stein, et al (US Patent 5,826,241).

As per claims 4-7, 12, neither Nymeyer nor Fernholz disclose the following, however Stein, et al discloses:

Wherein the Hollywood dollars are exchanged at a currency exchange web site...via a secured communication.../further comprising purchasing goods or services using the Hollywood dollars.../wherein a request for the purchase is transmitted to the vendor's.../wherein the vendor debits the first or second trader's account in the Hollywood dollars ...via a secure communication...(Col. 9, lines 49-54).

It would have been obvious to one of ordinary skill in the art to request an exchange, to purchase goods, to request a purchase, and to debit accounts through a website on the Internet via secure communications with the motivation of executing financial transactions on the Internet using the most common tools in Internet technology, thereby making the most logical, safest purchases with low risk factors. Stein doesn't specifically state that the exchange is done on a web site, however he does disclose that the exchange is done on the Internet making the implementation through a web site obvious.

### ***Response to Arguments***

5. The arguments filed 9/16/02 have been fully considered but are not persuasive.

As per claims 2-7 and 10-12, the examiner has withdrawn the 35 USC 112 rejection due to the amendment that cancels the term "Hollywood Dollars".

As per claims 1-3, 8-11 and 13-14, applicant argues that Nymeyer fails to disclose the "automatically generating additional buy orders or sell orders" step. However, Nymeyer discloses this step. Specifically in Col. 11, line 68-Col. 12, line 3, Nymeyer discloses that "at market" orders are determined by adding on minimum price increment to the closing price for buy orders and reducing the closing price by one minimum increment for sell orders. In this case, the increment/reduction to the closing price for buy and sell orders represent the additional buy orders and sell orders since this increment/reduction would change the value of the buy/sell order for a particular closing price.

In addition, the applicant argues that Fernholz fails to disclose generating electronic currency. However, this limitation is taught by Fernholz in Col. 12, lines 15-16 where the custodial bank is introduced. Fernholz shows that the custodial bank holds cash in electronic form. Then, lines 23-25 disclose that the custodial bank updates cash balance in each portfolio. In this case, updating the cash balance in electronic form represents the generation of electronic currency in each portfolio.

As per claims 3, 8, 11 and 13, these claims depend directly or indirectly from claims 1 and 9 and are rejected for the same reasons as discussed with respect to claims 1 and 9.

As per claims 4-7 and 12, the applicant argues that Stein et al does not supply the missing feature of automatically generating an electronic currency to execute the

buy and sell orders. However, as discussed above with respect to claims 1 and 9, Fernholz discloses this feature. Therefore, the combination of Nymeyer, Fernholz, and Stein discloses the limitations of claims 4-7 and 12.

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Akiba K Robinson-Boyce whose telephone number is 703-305-1340. The examiner can normally be reached on Monday-Friday 8:30 am- 5 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tariq Hafiz can be reached on 703-305-9643. The fax phone numbers for


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the organization where this application or proceeding is assigned are 703-746-7238

[After final communications, labeled "Box AF"], 703-746-7239 [Official Communications],

and 703-746-7150 [Informal/Draft Communications, labeled "PROPOSED" or "DRAFT"].

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.



A. R.-B.

April 21, 2003



TARIQ R. HAFIZ  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 3600